

## **REMARKS**

### **1. Summary of Office Action**

In the office action mailed April 8, 2008, (i) the Examiner objected to an informality in claim 23, and (ii) the Examiner rejected claims 1-3, 7-15, and 18-26 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2001/0049820 (hereinafter “Barton”) in view of U.S. Patent No. 7,039,933 (hereinafter “Chen”).

### **2. Amendments and Pending Claims**

Applicant has amended claims 1, 7-10, 12, 13, 20, 21, 23, and 24, cancelled claims 2, 3, 11, 14, 15, 18, 19, 22, and 25, and added new claims 27-34. Now pending in this application are claims 1, 7-10, 12, 13, 20, 21, 23, 24, and 26-34. Of the pending claims, 1 and 20 are independent.

### **3. Response to Claim Objections**

The Examiner objected to an informality in claim 23. In particular, the Examiner indicated that in claim 23, line 4, “time” should be replaced by “times.” Claim 23, line 4, as previously submitted, recited “time” twice. Applicant has amended claim 23 such that the first instance of “time” now recites “times.” Applicant submits that the amendment to claim 23 overcomes the Examiner’s objection to claim 23. Applicant respectfully requests that the Examiner withdraw the objection of claim 23.

### **4. Response to Claim Rejections**

The Examiner rejected independent claims 1 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Barton in view of Chen. Independent claims 1 and 20, as amended, patentably distinguish over Barton and Chen.

With respect to claims 1 and 20, at a minimum, Barton and Chen do not reasonably lead to placing the ad into the digital video output stream so that the digital video output stream includes the video of the first mode and the ad but does not include the video of the second mode, wherein the video of the first mode includes video of a user interface, and wherein the video of the second mode includes video of a program recorded at the digital video recorder (DVR), as recited in claims 1 and 20.

Barton pertains to a method for enhancing DVR television advertising viewership. (See, e.g., Barton, title and abstract). Barton, at best, discloses (i) a bookending function for displaying an advertisement before and/or after a program that has been recorded on a DVR's storage device is played to a viewer, (ii) bookending allows any ad material that is loaded onto the system to be displayed before and/or after any program material, (iii) visually presenting a viewer with a list of programs stored on the storage device, and (iv) using a viewer interface (e.g., a user menu) to select a desired program stored on the storage device. (See, e.g., Barton, abstract, and paragraphs 0014, 0018, 0028, 0030, 0042).

Chen pertains to an enhanced TV broadcasting system, method and program product that uses tags as markers for incorporating local content into a communication stream, such as a TV broadcast or a cable transmission. (See, e.g., Chen, title, and abstract). Chen, at best, discloses (i) an enhanced TV technology that uses certain technologies from the Internet to deliver graphical and informational elements as components on the same screen as a video program, (ii) the components are televised on top of video programming as enhancements and viewed on traditional TV sets, computers, and on other video-ready digital products, (iii) to a viewer, the enhancements

appear as graphical and sometimes purely informational elements on the screen and overlay a video broadcast, (iv) the enhancements may be opaquely colored and cover the video broadcast in part or may be transparent or semi-transparent, and (v) the TV broadcast may be shrunk down on the TV screen to make room for the enhancements which may be displayed beside the TV broadcast. (See, e.g., Chen, col. 1, lines 22-46).

With regards to claims 1 and 20, if Barton is combined with Chen, the combination of Barton and Chen, at best, discloses (i) using a viewer interface to present a viewer with a list of programs stored on the storage device of a DVR, and (ii) televising graphical and informational components on top of video programming, such that to a viewer, the graphical and informational components overlay the video programming or are displayed with a “shrunk down” version of a TV broadcast.

However, even if it is assumed, for the sake of argument, that the graphical and information components disclosed by Chen amount to the claimed “ad” and that the video programming upon which the graphical and informational components is overlaid amounts to the claimed video of the second mode (i.e., video that includes video of a program recorded at a DVR), the combination of Barton and Chen fails to reasonably lead to placing the ad into the digital video output stream so that the digital video output stream includes the video of the first mode and the ad but does not include the video of the second mode, wherein the video of the first mode includes video of a user interface, and wherein the video of the second mode includes video of a program recorded at the DVR, as recited in claims 1 and 20.

Because Applicant’s invention claimed in independent claims 1 and 20 does not reasonably follow from Barton and Chen, the invention recited in claims 1 and 20 is not

obvious over Barton and Chen. Consequently, Applicant submits that claims 1 and 20 are allowable. Further, because each of claims 7-10, 12, 13, 21, 23, 24, and 26-34 depend from one of claims 1 and 20 and necessarily include all of the limitations of one of claims 1 and 20, claims 7-10, 12, 13, 21, 23, 24, and 26-34 are allowable as well.

## **5. Conclusion**

Applicant believes that all of the pending claims have been addressed in this response. However, failure to address a specific rejection or assertion made by the Examiner does not signify that Applicant agrees with or concedes that rejection or assertion.

For the foregoing reasons, Applicant submits that claims 1, 7-10, 12, 13, 20, 21, 23, 24, and 26-34 are in condition for allowance. Therefore, Applicant respectfully requests favorable reconsideration and allowance of all of the claims.

Respectfully submitted,

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